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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/574,322

10/24/2006

Mesut Muyan

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9900

23859

7590

01/21/2009

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ATLANTA, GA 30309-3915

EXAMINER

BURKHART, MICHAEL D

ART UNIT

PAPER NUMBER

1633

MAIL DATE

DELIVERY MODE

01/21/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/574,322	<b>Applicant(s)</b> MUYAN ET AL.	
	<b>Examiner</b> MICHAEL BURKHART	<b>Art Unit</b> 1633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-9, 11-13, 15-23, 30, 50, 51, 55, 58-61, 64, 67-86, 88, 92 and 94 is/are pending in the application.
- 4a) Of the above claim(s) 3, 16, 18, 20, 22, 50, 51, 55, 58-61, 64, and 67-85 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 7-9, 11-13, 15, 17, 19, 21, 23, 30, 86, 88, 92 and 94 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

Receipt and entry of the amendment dated 10/3/2008 is acknowledged. After entry of the amendment, claims 1-5, 7-9, 11-13, 15-23, 30, 50, 51, 55, 58-61, 64, 67-86, 88, 92 and 94 are pending and claims 3, 16, 18, 20, 22, 50, 51, 55, 58-61, 64, and 67-85 remain withdrawn as directed to non-elected inventions. Claims 1, 2, 4, 5, 7-9, 11-13, 15, 17, 19, 21, 23, 30, 86, 88, 92 and 94 are under examination.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

### ***Claim Rejections - 35 USC § 102***

Claims 1, 2, 4, 5, 7-9, 11-13, 15,, 17, 19, 21, 23, 30, 86, 88, 92 and 94 are rejected under 35 U.S.C. 102(b) as being anticipated by Muyan et al (2001, of record) as evidenced by the Genbank Entry for Accession number P03372 (human estrogen receptor alpha, created July, 1986). **This rejection is maintained for reasons made of record in the Office Action dated 4/3/2008, and for reasons set forth below.**

### ***Response to Arguments***

Applicant's arguments filed 10/3/2008 have been fully considered but they are not persuasive. Applicants essentially assert that: 1) Muyan does not teach the limitations of claim 1 because the fusion proteins of Muyan include all of the domains of the estrogen receptors (ER), in contrast to disclosures in the present specification which detail that one way to use ER is to provide a "CDC" structure; 2) claim interpretation is done in light of the specification.

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Regarding 1 and 2), the case law applicants cite, *Phillips v. AWH Corp.*, upholds the standard used to make the rejection, i.e. "claims must be given their broadest reasonable interpretation consistent with the specification." See MPEP §2111, which discusses *Phillips v. AWH Corp* and further applies the standard that :

"reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim." The court found that applicant was advocating the latter, i.e., the impermissible importation of subject matter from the specification into the claim."

That is the case here: there are no limitations that the claimed compositions must have the "CDC" structure applicants assert is disclosed in the specification. Furthermore, there is no limiting definition of the W-Z-X formula as applicants assert: the "CDC" structure is described as only "one way" to achieve the W-Z-X structure using an ER, or that when using ERs, CDC "could be" the structure. The claims remain significantly broader: , i.e. claim 1 recites a composition comprising W, which is a "DNA binding domain", X is a "second DNA binding domain" and Z comprises a "hinge domain." Because Muyan et al teach all of these limitations for reasons of record, the claims are anticipated by Muyan et al.

Finally, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the claimed fusion protein comprise a "CDC" ER domain structure) are not recited in the

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rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

No claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL BURKHART whose telephone number is (571)272-2915. The examiner can normally be reached on M-F 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach can be reached on (571) 272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Burkhardt/  
Primary Examiner, Art Unit 1633